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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,625

03/08/2006

Heinz-Dieter Metzemacher

5628-26316

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35690

7590

02/10/2009

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EXAMINER

HU, HENRY S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,625	<b>Applicant(s)</b> METZEMACHER ET AL.	
	<b>Examiner</b> HENRY S. HU	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Pre-Amendment of July 6, 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15, 20, 22-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15, 20, 22-25 and 27-31 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5-1-2008, 11-6-2008, 8-25-2005 and 12-9-2005</u> .            | 6) <input type="checkbox"/> Other: _____                          |



1. It is noted that Applicants' **Pre-Amendment** and **four IDS**' (15 pages total) are filed so far. This Application is a **371/PCT/EP04/00071**. With such pre-amendment, **Claims 1-15, 20, 22-25 and 27 are amended, Claims 16-19, 21 and 26 are cancelled, while new Claims 28-31 are added.** Applicants allege that the support for claim amendment is as disclosed on page 10 of Remarks. **Claims 1-15, 20, 22-25 and 27-31 with only one independent claim** (Claim 1) are now pending. An action follows.

## **DETAILED ACTION**

### ***Election/Restrictions***

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1, this is based on the preliminary search done by the examiner as well as by examining the references cited in international search report and IDS filed by Applicants.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted as following:

I. **Claims 1-14, drawn to a pulverulent masterbatch composition.** It comprises a nanoclay as surface-coated specified.

- II. **Claim 15**, drawn to **a substantially homogeneous mixture** comprising two components including: (A) the composition of Group I, and (B) a polymer powder.
- III. **Claim 20**, drawn to **filler for use in polymers or polymer compositions** comprising the composition of Group I.
- IV. **Claims 22-24**, drawn to **a combination product comprising two filler components** including: (A) the filler of Group III, and (B) the flame-retardant filler.
- V. **Claim 25**, drawn to **a different filler for use in polyolefins and their mixtures, in engineering plastics and their mixtures, and alloys** comprising the composition of Group I.
- VI. **Claim 27**, drawn to **a product mixture comprising two components** including: (A) an elastomer or a thermoset, and (B) the composition of Group I.
- VII. **Claims 28-30**, drawn to **a three-step process for making a polymer or polymer composition.**

VIII. **Claim 31**, drawn to **a two-step process for making a pulverulent masterbatch composition.**

3. Where the group of inventions is claimed in one and the same international application, the requirement for unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “**special technical features**” shall mean those technical features that define a contribution which each of the claimed inventions considered as a whole, **makes over the prior art.** The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, although they share the special technical feature, this special technical feature does not define a contribution over the prior art for the following reasons:

4. In view of Examiner’s own prior art search as well as the references or articles cited in four **IDS**’ filed so far by Applicants, **Claims 1-15, 20, 22-25 and 27-31** is either obvious or anticipated by following: **WO 97/31873 to Dennis et al., WO 97/30950 to Gonzales et al., WO 02/100936 A1 to Dias et al., WO 01/40369 A1 to Bagrodia et al., and WO 00/78540 A1 to Singh et al.,** each individually or in combination. In summary, these eight groups have no common features in the preparation as well as its application since they are structurally different. The scope of the claims, i.e., the metes and boundaries are distinct. Accordingly, the special technical feature linking the inventions, the starting nonoclay material for each group does not

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provide a contribution over the prior art, and no single general inventive concept exists.

Therefore the restriction is appropriate.

5. With respect to the fact that “all groups are structurally different each other”, Groups I, II, IV and VI was each drawn to a different product such as a composition, a filler mixture or a product mixture, Group III and V was each drawn to different use claim, while Groups VII and VIII was each drawn to a different subject matter such as the process of making.

It is noted that the use claims (Claim 20 in Group III as well as Claim 25 in Group V) are improper according to MPEP since steps and/or sequence of using are NOT disclosed.

Although the subject matter from each group may comprise the same or at least similar type nonoclay as starting material, its structure, function and application are indeed different. Particularly three steps are specifically used in Group VII, while two steps are used in Group VIII. They are thereby not interchangeable.

6. Because these inventions are distinct for the reasons given above shown as different subject matters and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. It is noted that no phone call was made to **Scott R. Cox (registration # 31,945, tel: 502 589-4215)** by the examiner to request an oral election to the above restriction requirement due to the complexity on multiple (**eight**) distinct groups. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu whose telephone number is (571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Vasu Jagannathan, can be reached on (571) 272-1119. The **fax** number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peter D. Mulcahy/  
Primary Examiner, Art Unit 1796

/Henry S. Hu/  
Examiner, Art Unit 1796

February 3, 2009